Hovsepian v. Apple, Inc.

Doc. 70 Att. 9

EXHIBIT 10

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UNITED STATES DEPARTMENT OF COMMERCE
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NC

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR		ATTORNEY DOCKET NO.
08/630,590	04/10/96	YORT	F	2473.0001-02

LM02/0310

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EXAMINER	
LE, A	
ART UNIT	**PAPER NUMBER**
2734	15

DATE MAILED: 03/10/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

PTO-90C (Rev. 2/95)

1- File Copy

Exhibit 10 Page 107

Office Action Summary	Application No. 08/630,590	Applicant(s) Paul Yurt et al	
	Examiner Amanda T. Le		Group Art Unit 2734

☒ Responsive to communication(s) filed on *9/10/98*.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *33-42* is/are pending in the application.

Of the above, claim(s) ______ is/are withdrawn from consideration.

☐ Claim(s) ______ is/are allowed.

☒ Claim(s) *33-42* is/are rejected.

☐ Claim(s) ______ is/are objected to.

☐ Claims ______ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on ______ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on ______ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) ______.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: ______.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). ______

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

1. Claims 33-42 are pending in this application.

Continued Prosecution Application

2. The request filed on 09/10/98 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/630,590 is acceptable and a CPA has been established. An action on the CPA follows.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. Claims 33 and 34 are rejected under 35 U.S.C. 102(e) as being anticipated by Ballantyne et al (5,133,079).

Regarding claim 33, Ballantyne et al's apparatus for distribution of movies teaches the following claimed subject matters: "a plurality of libraries" (Fig. 1b, element 32); "identification encoding means" (Fig. 1b, elements 16), "conversion means" and "transmitter means" (fig. 1a, 20 through 24). With respect to the claimed limitation "the remote location selected by the user wherein the remote location may be different form the accessing location", Ballantyne et al inherently teaches this claimed subject matters (see col. 6, lines 35-38). Mainly, in the prior art system, the user can make the request using the phone system ("accessing location"). The prior art system does not restrict the user to be present at the location, for example in the same room, of the television ("remote location"). In other words, the phone system ("accessing location") and the television ("remote location") do not have to be at the same location. Ballantyne et al, therefore, teaches all the claimed limitations.

Regarding claim 34, Ballantyne et al further teaches the claimed limitation of "the plurality of libraries geographically separated" (col. 4, lines 50-56).

5. Claims 35-42 are rejected under 35 U.S.C. 102(e) as being anticipated by Hoarty et al (5,093,718).

Regarding claims 35, 36, 39-41, Hoarty et al's interactive home information system discloses the following claimed subject matters: "local reception system" (Fig. 1, NODE 12); "subscribers" (Fig. 1, HIC 16); "means for receiving compressed, digitized data" (Fig. 6A, 64, 68, col. 12, lines 13-15); "means for storing" (Fig. 6A, 70); "means for transmitting" (Fig. 6A, 102, col. 13, lines 28-38).

Regarding claims 37, 38 and 42, Hoarty et al further discloses the claimed "processing station" (Fig. 1, REGIONAL PROCESSING CENTER 4, col. 6, line 29-col. 7, line 45).

Conclusion

6. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications intended for entry)

Or:

(703) 308-6743, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amanda Le, whose telephone number is (703) 305-4769. The Examiner can normally be reached on Tuesday-Friday from 8:00 A.M. - 5:30 P.M.. The examiner can also be reached on alternate Monday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Chin, can be reached on (703)305-4714.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4900.

Amanda Le

March 3, 1999

Amanda T. Le
Primary Patent Examiner